

REMARKS

Claims 32-42 were subject to a requirement for restriction. More specifically, the Examiner identifies claims 32, 37, 38 and 42 as generic claims, and restricts the claims to one of the following allegedly distinct species:

Species A- Claims 33, 34 and 36 (drawn to restraining magnets using a nonmagnetic frame)

Species B- Claim 35 (drawn to restraining magnets using a 3-axis ball screw driven linear slide)

Species C- Claim 39-41 (drawn to restraining magnets using an adhesive)

Applicants elect the claims of **Species A** with traverse. Applicants traverse the restriction requirement of the Office Action on the ground that restriction is improper. The Office Action states that an election with traverse must distinctly and specifically point out supposed errors in the restriction requirement. Accordingly, Applicants submit the following arguments as evidence that the restriction requirement is improper.

M.P.E.P §803 states in salient portion (emphasis added):

“...If the search and examination of all the claims in an application **can be made without serious burden**, the examiner **must** examine them on the merits, **even though** they include claims to independent or distinct inventions.

I. CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are **two criteria** for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and

(B) There would be a **serious burden** on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).”

Accordingly, restriction is proper **only** where the claimed inventions are either independent or distinct, **and** further where the Examiner would be **seriously** burdened without a restriction. The Office Action only contends that the alleged species are distinct species.

First, Applicant submits that the current claims do not describe multiple patentably distinct inventions. In imposing the restriction requirement, the Office Action states that Species A-C are distinct in that they each uniquely require restraining magnets by a nonmagnetic frame, by a 3-axis ball screw driven linear slide, and by an adhesive, respectively. The Office Action fails to provide any additional basis for the alleged species being distinct. Applicants note that the **mere** fact that one element is required only in one dependent claim while another element is required only in another dependent claim, in and of itself, does **not** mean that the claims are directed to **distinct** species. M.P.E.P. §806.05(j) states in a salient portion (emphasis added):

“For other related product inventions, or related process inventions, the inventions are **distinct if**

(A) the inventions as claimed **do not overlap in scope**, i.e., are mutually exclusive;

(B) the inventions as claimed are not obvious variants; **and**

(C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.
See MPEP § 802.01.

The **burden is on the examiner to provide an example** to support the determination that the inventions are distinct, but the example need not be documented.”

As Applicants understand M.P.E.P. §806.05(j), each of the above conditions (A), (B) **and** (C) must be met in order for related process inventions to be distinct. Accordingly, Species A-C are **not** distinct if, for example, it is shown that they are **not mutually exclusive**.

The Office Action **fails** to allege that any claims are mutually exclusive, and Applicants assert that the claims of alleged Species A, B and C are **not** mutually exclusive. Claim 33 in alleged Species A recites mechanically restraining the first permanent magnet block from moving in the **first** direction using a nonmagnetic frame. Claim 35 in alleged Species B recites mechanically restraining the first permanent magnet block from moving in the **second** direction with a 3-axis ball screw driven linear slide. Claim 39 in alleged Species C recites **further** restraining the restrained first permanent magnet block with an adhesive. Applicants note that none of claims 33, 35 and 39 are mutually exclusive of the other, and

that the respective restraining in a first direction, restraining in a second direction, and further restraining are capable of use together. By way of illustration, a first magnet may at one time be restrained in a first direction using a nonmagnetic frame, restrained in a second direction with a 3-axis ball screw driven linear slide, and further restrained by (1) applying adhesive to at least one side of one of the permanent magnet blocks, and (2) adhering the first permanent magnet block to a permanent magnet block in the plurality of permanent magnet blocks. For at least the foregoing reasons, claims 33, 35 and 39 are **not** mutually exclusive, and are therefore **not** directed to distinct species.

Second, assuming *arguendo* that the current claims did describe patentably distinct inventions, which Applicants do not agree, there would be **no serious burden** on the Examiner if restriction is not required. By way of illustration, Applicants have **previously** presented dependent claims which each uniquely required restraining magnets by different respective means – as with withdrawn claims 13, 15 and 16, for example. Such claims were presented **without** any allegedly distinct species being identified or any alleged undue burden in the prosecution of such claims being cited as a reason for a restriction requirement. For at least the foregoing reasons, Applicants request that the above restriction requirement of the pending claims be withdrawn.